



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/013,121	12/07/2001	Timothy E. Walsh	12334 B	9470

7590

05/20/2004

Charles E. Baxley
Hart, Baxley, Daniels & Holton
90 John Street, Third Floor
New York, NY 10038

EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
----------	--------------

3677

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary

Application No.

10/013,121

Applicant(s)

WALSH ET AL. *WU*

Examiner

Ruth C Rodriguez

Art Unit

3677

All participants (applicant, applicant's representative, PTO personnel):

(1) Ruth C Rodriguez, PTO.

(3) _____

(2) Bernie Hoffman, Reg. 30,756, Applicant's represent.

(4) _____

Date of Interview: 13 May 2004.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____

Claim(s) discussed: All.

Identification of prior art discussed: Walsh et al. (US 5,195,789).

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Ruth C. Rodriguez
Examiner's signature, if required

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Hoffman called the Examiner on May 11, 2004 to discuss the Advisory Action mailed on 29 April 2004. Mr. Hoffman indicated that the rejection of the claims under 35 U.S.C. 103(a) as being unpatentable over Walsh et al. in view of Cohn and Arnoldt et al. includes a design choice rejection based on a change in shape for a folded free edge. Mr. Hoffman cited *In re Chu*, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995) to establish that the advantages derived from a design choice modification do not have to appear in the original drawings and specifications. After careful study of *In re Chu*, the Examiner informed Mr. Hoffman that the determination of validity of the design choice modification for this case was based on arguments and evidence where the evidence presented by the Applicant was enough proof to invalidate the obviousness of the design choice modification. For the current application, the Applicant has only provided arguments supporting his position but no evidence supporting this position has been provided. The arguments provided by the Applicant are not sufficient to overcome this rejection. Mr. Hoffman indicated his willingness to provide an affidavit under 37 CFR 132 as evidence where the affidavit will be signed by the engineer that worked on the invention. The Examiner indicated that the evidence will have to come from someone outside of the Applicant's organization unless the evidence is directed to other considerations of patentability. In order to resolve this situation, Mr. Hoffman proposed the submittal of a continuation in part application where the arguments presented by the Applicant will be included to support the change in shape modification. The Examiner indicated that the filling of a new application will indeed resolve this issue and also indicated that this continuation in part will be considered allowable over the prior art of record. An agreement was reached where Mr. Hoffman will suggest this solution to the Applicant.